



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/486,784	03/01/2000	RALF DONNER	4797-8PUS	2441

7590 03/16/2004

THOMAS C PONTANI
COHEN PONTANI LIEBERMAN & PAVANE
551 FIFTH AVENUE
SUITE 1210
NEW YORK, NY 10176

EXAMINER

RIDLEY, BASIA ANNA

ART UNIT	PAPER NUMBER
----------	--------------

1764

DATE MAILED: 03/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/486,784	Applicant(s) DONNER ET AL.	
	Examiner <i>BR</i> Basia Ridley	Art Unit 1764	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 March 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claim(s) 6-17 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specifically:

- claim(s) 6-7 recites the limitation “a ceramic protection for the cooling wall on a side of the cooling wall facing the cooling gap”. The applicant is relying for support of this limitation on Fig. 1 (see last paragraph on page 8 of response filed on 5 December 2003). Said limitation is not supported by the specification as originally filed. Applicant’s attention is directed to Fig. 1-2, which clearly show (in the order from outside of the reactor towards inside of the reactor): pressure shell, water cooled gap, cooling wall, ceramic protection layer, and refractory lining. The drawings clearly show that the ceramic protection is on the side of cooling wall facing the reaction chamber and not on the side facing the water cooled gap. Neither the specification nor the drawings describe an embodiment where the ceramic protection for the cooling wall is on the side of the cooling wall facing the cooling gap. Further this limitation is contradictory to limitations recited in claims 8-9, which recite that said cooling wall comprises half tubes and that the half tubes are “arranged on a side of the ceramic protection facing the cooling gap”.

Art Unit: 1764

- claim(s) 6-7 recites the limitation “a layer of slag on an internal surface of the cooling wall facing the reacting chamber”. The applicant is relying for support of this limitation on Fig. 1 (see last paragraph on page 8 of response filed on 5 December 2003). Said limitation is not supported by the specification as originally filed. Applicant’s attention is directed to Fig. 1-2, which clearly show that the internal surface of the cooling wall facing the reacting chamber is covered with a ceramic protection. Therefore, while the specification discloses that the layer of slag is located on the side of the cooling wall facing the reaction chamber, it is not located on the “internal surface of the cooling wall” but rather on the internal surface of the ceramic protection layer, replacing the refractory lining (see page 6, lines 16-24 of instant specification). Neither the specification or the drawings describe an embodiment where the layer of slag is located on an internal surface of the cooling wall.

- claims 16-17 recite the limitation “the pressure shell is connected to the cooling wall only at the input opening and the outlet opening”. The applicant is relying for support of this limitation on Fig. 1 (see last paragraph on page 8 of response filed on 5 December 2003). Said limitation is not supported by the specification as originally filed. While Fig. 1 does, in fact, show an apparatus where the pressure shell is connected to the cooling wall only at the input opening and the outlet opening, the applicant is reminded that the drawings in patent application do not have to show every feature of the invention. Therefore the fact that features (such as additional connections between the pressure shell and the cooling wall) are not shown in the drawings, absent more (i.e. a specific teaching in the specification excluding apparatuses where there are additional connection points between the pressure shell and the cooling wall), does not exclude apparatuses comprising said features. The mere fact that a feature is not presented in the

Art Unit: 1764

drawings does not support negative claim limitations excluding said feature.

If applicant were to remove the language identified above as new matter, the claims would stand rejected as set forth in the Office action mailed on 3 July 2003.

Response to Arguments

3. Applicant's arguments filed on 5 December 2003 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Basia Ridley, whose telephone number is (571) 272-1453. The examiner can normally be reached on Monday through Thursday, from 9:00 AM to 7:30 PM.

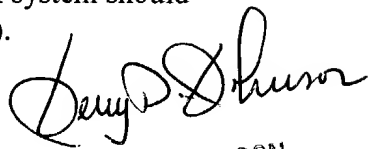
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola, can be reached on (571) 272-1444.

Art Unit: 1764

The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Technical Center 1700 General Information Telephone No. is (571) 272-1700. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Questions on access to the Private PAIR system should be directed to the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).


Basia Ridley
Examiner
Art Unit 1764


JERRY D. JOHNSON
PRIMARY EXAMINER
GROUP 1100

BR

March 2, 2004